

**REMARKS**

This Amendment and the following remarks are intended to fully respond to the Office Action dated March 25, 2005. In that Office Action claims 33-64 were examined, and all claims were rejected. More specifically, claims 33-62, and 64 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Beaton et al. (U.S.P.N. 6,037,937), and Eftekhari (U.S. Publ. No. 2002/0024505); and claim 63 was rejected under 35 U.S.C. § 103(a) as being unpatentable over Beaton et al., Eftekhari, and Hoeksma (U.S.P.N. 6,271,835). Reconsideration of these rejections is respectfully requested in light of the above amendments and following remarks.

In this Response, claims 33, 35, 37, 39-40, 43, 45-46, 51-57, 59-61 and 63-64 remain pending in the application.

**I. Claim Amendments**

Independent claim 33 has been amended to incorporate the subject matter of dependent claim 34. In particular, claim 33 now recites the step of “positioning the control image in the background of the display proximate to the input element” in order to associate the control image with the input element. Thus, independent claim 33 now recites a method for providing a user interface for an electronic device having an input element on the housing separate from the display (i.e., the input element does not constitute a touch-screen), where a control image displayed in the background of the device’s display is positioned proximate to the input element. Claim 34 was canceled due to its inclusion with independent claim 33.

Similar amendments were made to claims 35 and 37 (incorporating the method steps of claims 36 and 38, which claims were in turn canceled). Claim 35 thus depends from claim 33 and recites a plurality of input elements and a plurality of background control images positioned proximate to the input elements. Claim 37 recites that the device display is separated into a plurality of regions where a separate input element is positioned proximate to each display region, and wherein each background control image is positioned within a separate region.

Dependent claims 41 and 42 previously recited that the input element was a joystick (or other enumerated control) providing for movement in at least two directions. Due to the amendment of independent claim 33 to specifically recite that the input element was positioned

proximate to the control image, dependent claims 41 and 42 were canceled (since a multi-directional input element need not be positioned proximate to a control image). Independent claim 43 was then amended to specifically recite the invention of former dependent claim 41 (as well as dependent claim 53 from the second claim set). In light of the amendments to independent claim 43, numerous dependent claims within the second claim set (e.g., those reciting a “plurality” of input elements, or claims reciting the step of positioning the control image “proximate” to the input element) have been canceled or amended since such claims are no longer relevant to a single, multi-directional input element.

Lastly, independent claim 55 (reciting a “computer-readable medium”) has been amended in similar fashion to independent claim 33 by incorporating the limitation of former dependent claim 58 (i.e., “positioning the control image in the control screen proximate to the input element”). A similar amendment was made to claim 60 (defining a plurality of control images positioned proximate to separate input elements), which incorporated the subject matter of canceled claim 62.

These claim amendments are described in greater detail below in response to the pending obviousness rejections.

## **II. Claim Rejections – 35 U.S.C. § 103**

Applicant respectfully traverses the § 103 rejections based on the combination of Beaton et al. (U.S.P.N. 6,037,937) and Eftekhari (U.S. Publ. No. 2002/0024505), as those rejections might now be applied to the currently amended claims.

### **Independent Claims 33 and 55**

As noted above, the first and third claim sets have been amended to specifically recite that a control image displayed in the background of the device’s display is “positioned proximate to the input element” on the housing of the device. This element is neither taught nor suggested by either of the cited references and, as noted below, the cited references actually teach away from the claimed invention. Because this element is completely lacking from the cited references, there can be no prima facie case of obviousness (MPEP § 706.02(j) and §§ 2142-43).

In particular, while Beaton includes a control image in the background of a touch screen display, the Examiner admits that Beaton does not teach associating the background control image with an input element that is **separate** from the display so that activation of the input element initiates performance of the task indicated by the control image. (Office action at pp. 3 and 9.) For this missing teaching, the Examiner relies on paragraph [0017] of the Eftekhari publication which purportedly teaches “the matching each of color input button of a handheld device with a function on the display.” (Office action at p. 9.) Specifically, the Examiner states that “the combination of Beaton and Eftekhari read on the claim language of associating the control image with the input element so that activation of the input element initiates performance of the task indicated by the control image.” Id.

While Applicant does not agree with the broad statement of the combined teaching of the two cited references, the claims have been amended to address the Examiner’s argument. In particular, independent claims 33 and 55 no longer recite a broad “association” of the control image with the input element, but rather have been amended to specifically recite the step of positioning the control image “proximate” to the input element in order to effect such an association. Locating the control image proximate to the input element (e.g., a button) is not taught by either Beaton (which discloses a touch screen) or Eftekhari (which teaches the use of color-coordinated links on a telephone keypad that is physically separated from the display).

Thus, both Beaton and Eftekhari fail to teach or suggest the invention recited in amended claims 33 and 55. Indeed, Eftekhari actually **teaches away** from the pending claims by utilizing a relatively large number of color-coded keys (e.g., 12 keys on a conventional telephone keypad) to provide more options than would otherwise be available with a limited number of “soft-keys.” See the description of ATM-style soft-keys at pp. 1-2 of the Eftekhari parent application, as well as the “Summary of the Invention” on p. 4 (fourth paragraph) which notes that a further advantage of the invention is that “the display, though it may be too full of links to see a **positional correlation** with nearby buttons, is still close enough to the buttons, that the button colors may be seen with peripheral vision” (emphasis added). Thus, Eftekhari states that the color-coded buttons are used **in place of soft-key buttons that rely on positional correlation** with elements in the display. Since claims 33 and 55 have been amended to specifically recite

the same type of “soft keys” and positional correlation that were distinguished by Eftekhari itself, it is clear that Eftekhari teaches away from the present invention.

In sum, neither of the cited references, either alone or in combination, teach the invention of independent claims 33 and 55. Specifically, Beaton teaches the use of a touch screen to manipulate background control images, while Eftekhari merely teaches the use of color-coded keys having no positional correlation with the on-screen links. There is simply no suggestion within the cited references to position a background control image **proximate to** an input element that is located on the housing of the electronic device and that is not part of the display itself (i.e., where the input element is not a touch screen). Furthermore, Eftekhari specifically distinguishes the use of soft-keys or “input elements” that rely on positional correlation with the information on the display. In light of the above amendments and remarks, Applicant respectfully requests reconsideration of the § 103(a) rejections of independent claims 33 and 55.

#### Independent Claim 43

Due to the amendment of independent claims 33 and 55 to recite positioning the control image on the screen proximate to an input element, independent claim 43 was amended to recite the remaining embodiment of an input element (such as a joystick) that provides for movement in at least two directions. Because such an input element need not be positioned “proximate” to the control images, this embodiment was canceled from the first and third claim sets and recited separately in the second claim set beginning with independent claim 43.

The specific recitation of independent claim 43 was previously found in dependent claim 53, and thus the amendments to claim 43 do not constitute new matter nor should they necessitate a new search on the part of the Patent Office. In rejecting prior dependent claims 41 and 53, the Office action cited col. 1, lines 56-64 of the Beaton patent for allegedly showing a multi-directional input element. However, the cited portion of Beaton only describes **graphical on-screen controls** such as arrows or scroll bars that are used as substitutes for hard-keys. Furthermore, the cited portion of Beaton merely constitutes background disclosure relative to the invention of Beaton (i.e., the use of a touch screen to activate background control images). Thus, Beaton does not teach or suggest the recited multi-directional input element (e.g., a joystick, rocker switch, etc.) that allows a user to select one of a plurality of background control images.

Additionally, Eftekhari discloses only conventional push buttons for activating on-screen links (where one button is associated with one link), and therefore does not teach or suggest the use of a multi-directional input element for activating a plurality of different background control images. Therefore, in light of the above remarks, Applicant respectfully requests reconsideration of the patentability of independent claims 43.

Dependent claims

While a number of the prior dependent claims have been canceled due to the above-described amendments to the independent claims, Applicant includes the following remarks pertaining to select ones of the remaining dependent claims.

Dependent claims 37 and 61 recite the inclusion of defined regions within the display so that each of the background control images can be placed within one of the regions, wherein one of the input elements is positioned proximate to each of the defined regions. Although p. 4 of the Office action states that Beaton allegedly shows the use of “defined regions,” a review of the cited portions (col. 6, lines 35-43) indicates that Beaton does **not** disclose or suggest using defined regions for different control images. Indeed, due to the disclosed use of a touch screen as opposed to soft-keys or “input elements” that are located proximate to the control image, Beaton actually “**teaches away**” from the use of defined regions (i.e., there is no reason to delegate control images to separate regions if a user can simply press a touch screen to activate the control image). Therefore, in addition to the reasons noted above for the patentability of independent claims 33 and 55, Applicant further requests reconsideration of the obviousness rejections of dependent claims 37 and 61.

Dependent claims 40, 52 and 64 (and newly amended claim 53) recite that the electronic device further comprises a watch. The Office action cites col. 4, lines 10-14 of the Beaton patent for allegedly teaching that the electronic device may comprise a watch. However, while the cited portion of Beaton discloses a “clock generator” within the electronic circuitry of the device, the cited portion of the Beaton patent does not disclose or suggest using the device as a “watch” as that term was defined and shown in the present application (e.g., as shown in Figs. 3A-3C). Therefore, Applicant further requests reconsideration of the obviousness rejections of these dependent claims.

No Prima Facie Case of Obviousness

In summary, the combination of Beaton and Eftekhari does not create a prima facie case of obviousness for independent claims 33 and 55. First, the purported combination of the two references does not include each of the recited independent claim elements (e.g., there is no disclosure of positioning an input element on a housing of the device proximate to a background control image in the device display). Secondly, there is no suggestion or teaching in either of the references to make such a combination. Rather, Beaton's use of a touch screen display to activate the control images **teaches away** from the use of soft-keys that are positioned proximate to the control images on the device housing. Similarly, Eftekhari **teaches away** from the present invention by **specifically distinguishing the use of soft-keys having a positional correlation** to the on-screen control (due to the inherent limitation in the available number of such soft keys), opting instead for a larger number of color-coded keys that are positioned away from the screen but that are still within a user's peripheral vision when looking at the display (see the Eftekhari parent application at pp. 1, 4 and 9). Similarly, the combination of the two cited references fails to teach or suggest the use a multi-directional input element (such as a joystick) to activate a plurality of background control images, as recited in independent claim 43.

The Examiner has cited several cases for the proposition that "one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references." (Office action at pp. 8-9.) However, Applicant's arguments do not constitute separate attacks on the two cited references. Rather, in light of the above amendments and remarks, Applicant has shown that there is simply no prima facie case of obviousness since a key element of the claims (e.g., positioning the input element proximate to the control image) is not disclosed or taught in either of the cited references, and thus is also missing from any purported **combination** of the references.<sup>1</sup> Indeed, as noted above, the references taken in combination actually teach away from the recited invention.

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<sup>1</sup> In the primary legal opinion cited by the Examiner, the court had previously determined that a prima facie case of obviousness had been demonstrated and, in response to an affidavit relating to only one of the cited references, the court noted that "one cannot show non-obviousness by attacking references individually where, as here, the rejections are based on combinations of references." *In re Keller*, 208 U.S.P.Q. 871, 882 (C.C.P.A. 1981). This citation is not relevant to the current application where no prima facie case of obviousness has been made.

**III. Applicant does not waive argument that Eftekhari does not constitute “prior art”**

As previously noted, Applicant does not admit that the cited Eftekhari publication (U.S. Publ. No. 2002/0024505) constitutes prior art to the present application, particularly in light of the previously submitted Rule 131 declaration and the arguments pertaining to MPEP § 2136.03 (and the Wertheim decision cited therein). In sum, because Applicant has sworn behind the filing date of the Eftekhari publication, and because the parent application is abandoned, Eftekhari can only be granted the effective priority date of the abandoned parent if Eftekhari includes **issued claims** that are fully supported by the disclosure of the abandoned parent application. At this stage, Eftekhari is still being prosecuted before the PTO and thus has no “issued claims.” If Eftekhari should go abandoned, or issue with claims that are not supported by the abandoned parent application, it will be clear that Eftekhari cannot be used as a prior art reference as of the date of the abandoned parent application. Indeed, a recent scan of the PAIR database shows that all claims of the Eftekhari application stand rejected. Therefore, Applicant’s election to proceed by distinguishing the Eftekhari application (as noted in the above amendments and remarks) should not be viewed as a waiver of Applicant’s rights to challenge the prior art nature of any patent which ultimately issues from the Eftekhari application.

**Conclusion**

All the pending claims in the present application are believed to be in condition for allowance, and such action is respectfully requested. Furthermore, since the above amendments and remarks are believed to fully distinguish the applied references, any remaining arguments supporting the rejected claims are not acquiesced to because they are not addressed herein. Should any additional issues need to be resolved, the Examiner is requested to telephone the undersigned to attempt to resolve those issues.

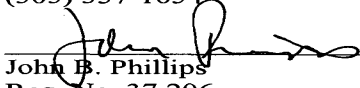
It is believed that no fees are due with this Response. However, the Commissioner is hereby authorized to charge any deficiencies or credit any overpayment with respect to this patent application to deposit account number 13-2725.

Respectfully submitted,

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